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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,947	02/28/2005	Takatsugu Yamada	XA-10279	2544

181 7590 04/20/2007
MILES & STOCKBRIDGE PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN, VA 22102-3833

EXAMINER

BINDA, GREGORY JOHN

ART UNIT	PAPER NUMBER
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3679

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/525,947	Applicant(s) YAMADA ET AL.	
	Examiner Greg Binda	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 1-4,9-19,22-25 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-8,20,21,26,27,29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/28/05; 10/11/05; 8/21/06</u> | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Applicant's election of the Species XIV, the dust cover shown in Fig. 14 in the reply filed on March 28, 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 1-4, 9-19, 22-25 & 28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 28, 2007.

In the reply applicant identified claim 28 as reading on the elected species. However, the limitations at the end of that claim do not read on the elected species. Instead it appear this claim reads only on an unelected species, for example that which is shown in Fig. 6.

Drawings

3. The drawings are objected to because:

- a. Reference numerals 10, 12, 14 are used to identify particular features in Fig. 1 and then reused to identify modification of those features in Figs. 2+. Such usage is proscribed. See MPEP § 608.02(e)
- b. In Fig. 1 the lead line for reference numeral 12 fails to lead to an iron pipe.
- c. Fig. 7 fails to show the features 13, 13c & 13d made from different materials as described at page 27, lines 3 & 18-22.

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4. Figure 16 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 5-8, 20, 21 & 26-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. The term "low" in claims 1 & 29 is a relative term which renders the claims indefinite. The term "low" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.
- b. Claim 6 contains the trademark/trade name TEFLON. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a low friction material and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 5, 7 & 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Reynolds, US 2,358,536. Figs. 1 & 2 show a dust cover 5 for a steering shaft 2 attached to a vehicle body in such a way as to be in contact with the steering shaft to provide protection against dust and muddy water, comprising: a cylindrical contact member 10 that is to be in sliding contact with the steering shaft while the steering shaft is rotating, wherein the cylindrical contact member is made of a low friction material (see “good bearing material” at page 2, line 3). Figs. 1 & 2 show the dust cover 5 is provided with a sealing lip 9 that is contact with the steering shaft 2 to provide a sealing function. Fig. 1 shows a bellows portion 8 having elasticity is provided between the cylindrical contact member 10 and a portion 3 attached to the vehicle body.

11. Claims 5-8, 20 & 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakairi et al, US 5,669,718 (Sakairi). Figs. 1-4 show a dust cover 20 for a steering shaft 25 attached to a vehicle (see col. 1, line 5) body in such a way as to be in contact with the steering shaft to provide protection against dust and muddy water, comprising: a cylindrical contact member 22 that is to be in sliding contact with the steering shaft while the steering shaft is rotating, wherein the cylindrical contact member is made of a low friction material (see “synthetic resin layer” in

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col. 6, lines 34-40). Figs. 1 & 4 show the dust cover 20 is provided with a sealing lip 32 that is contact with the steering shaft 25 to provide a sealing function. Fig. 1 shows a bellows portion 39 having elasticity (see “elastic rubber” in col. 5, line 44) is provided between the cylindrical contact member 22 and a portion 38 attached to the vehicle body.

12. Claims 5-8, 20, 21 & 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Reed et al, US 4,553,760 (Reed). Figs. 1-4 show a dust cover 50 for a steering shaft 16 attached to a vehicle body in such a way as to be in contact with the steering shaft to provide protection against dust and muddy water, comprising: a cylindrical contact member 56 that is to be in sliding contact with the steering shaft while the steering shaft is rotating, wherein the cylindrical contact member is made of a low friction material (see “nylon or polycarbonate” and “glass fibers” in col. 2, lines 59-62). Figs. 1 & 3 show the dust cover 50 is provided with a sealing lip 64 that is contact with the steering shaft 25 to provide a sealing function. Fig. 3 shows a bellows portion 54 having elasticity (see “elastomeric” in col. 2, line 43) is provided between the cylindrical contact member 56 and a portion 58 attached to the vehicle body. Figs. 2-4 show a number of grooves 74 extending in the axial direction are formed on the inner circumference 70 of the cylindrical contact member 56.

13. Claims 5-8, 20 & 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Cather, US 4,274,641. Cather shows a dust cover 10 for a steering shaft 18 attached to a vehicle body in such a way as to be in contact with the steering shaft to provide protection against dust and muddy water, comprising: a cylindrical contact member 46 that is to be in sliding contact with

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the steering shaft while the steering shaft is rotating, wherein the cylindrical contact member is made of TEFLON (see "polytetrafluoroethylene" in col. 2, line 25). Cather shows the dust cover 10 is provided with a sealing lip 38 that is contact with the steering shaft 18 to provide a sealing function. Cather shows a bellows portion 26 having elasticity is provided between the cylindrical contact member 46 and a portion 22 attached to the vehicle body.

14. Claims 5-8, 20, 21, 27, 29 & 30 are rejected under 35 U.S.C. 102(b) as being anticipated by McMillen, US 5,897,119. Figs. 3 & 4 show a dust cover 10 for a steering shaft 14 attached to a vehicle body in such a way as to be in contact with the steering shaft to provide protection against dust and muddy water, comprising: a cylindrical contact member 50 that is to be in sliding contact with the steering shaft while the steering shaft is rotating, wherein the cylindrical contact member is made of TEFLON (see "polytetrafluoroethylene" in col. 5, line 47). Figs. 3 & 4 show the dust cover 10 is provided with a sealing lip 36, 38 that is contact with the steering shaft 14 to provide a sealing function. Figs. 3 & 4 show a plurality of bellows portions 32, 34 having elasticity is provided between the cylindrical contact member 50 and a portion 12 attached to the vehicle body.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Masury, Hubbard and Rzeppa each show a dust cover.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Binda whose telephone number is (571) 272-7077. The examiner can normally be reached on M-F 9:30 am to 7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Greg Binda
Primary Examiner
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